

## **REMARKS**

Claims 15, 19, 29 and 37 have been amended. No claims have been added or cancelled. Claims 1-37 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

### **Section 101 Rejection:**

The Examiner rejected claims 15, 19, 29 and 37 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Claims 15, 19, 29 and 37 have been amended to recite a tangible, computer-accessible medium. Withdrawal of the § 101 rejection is respectfully requested.

### **Section 112, Second Paragraph, Rejection:**

The Examiner rejected claims 1-11, 15, 16 and 19 under 35 U.S.C. § 112 second paragraph as indefinite. Applicant respectfully traverses this rejection, for at least the reasons below.

The Examiner rejects claims 1, 15, and 19 arguing that these claims recite storing one or more records in a database, but do not specify where the database is located (i.e. is it located on a server; is it separate from all devices in the network, etc?). The Examiner requests that Applicant amend these claims, “and be more specific because of this ambiguity.” However, there is no requirement under 35 U.S.C. § 112, second paragraph to amend claims to recite any particular embodiment. The Examiner is attempting to reject claims 1, 15 and 19 merely because they recite limitations that may encompass more than one specific embodiment. The Examiner has merely pointed out that claims 1, 15 and 19 broadly encompass more than one embodiment related to the location of the database. Moreover, “[b]readth of a claim is not to be equated with indefiniteness.” M.P.E.P. § 2173.04; *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). Additionally, “[i]f the scope of the subject matter embraced by the claims is clear, and if

applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. *See, e.g.,* M.P.E.P. 2173.04. Applicant asserts that the meaning of claims 1, 15, and 19 is clear and would be readily ascertained by one of ordinary skill in the art. Thus, claims 1, 15 and 19 clearly comply with 35 U.S.C. 112, second paragraph.

The Examiner also rejects claims 1, 15, and 19 under 35 U.S.C. § 112 second paragraph arguing that these claims recite sending a request for information to a first computer, but do “not say what device is sending said request for information.” As noted above, the Examiner is attempting to reject these claims because they are not limited to a particular embodiment. Instead, the claims recite limitations that may encompass multiple embodiments. However, as noted above, it is well settled law that breadth of a claim should not be equated with indefiniteness.

The Examiner also contends that if the request for information, as recited in claims 1, 15 and 19, is in response to a request from the first computer, the device sending the request for information would already have an Internet address for the first device. The Examiner questions why the device would need to re-request the Internet address corresponding to the first computer if the sending device already has the Internet address and is using that Internet address to send the request. First of all, the Examiner is improperly assuming limitations that are not recited in the claims. Second, even if the information was already available, requesting the information does not make the claim indefinite. Third, there are numerous reasons why it might be desirable to request the address even if a previous request had been received. For example, requesting the computer that is accessing the web site to provide a unique identification in the form of an Internet address and a time value allows the requesting computer to identify itself rather than the system requesting the information making the association of an Internet address and a time value.

The Examiner also rejects claims 1, 9, 15, 16, and 19, for reciting the limitation, “storing one or more records in a database, wherein each record comprises an Internet

address and a time value, and wherein each record corresponds to a different computer accessing said web site” before limitations of “receiving a first request from a first computer to access said web site; sending a request for information to said first computer, wherein said information comprises a first Internet address and a first time value corresponding to said first computer.” The Examiner states that “[t]his order seems redundant since the system has just finished the act of ‘storing’ a record which comprises an Internet address and a time value, then sends a request for ‘information’ which is the same as the ‘record’”. First of all, the Examiner is incorrect to assume a specific order of operation from the order in which elements of the claims are recited. Second, as explained below, the meaning of the claims is clearly definite.

The Examiner requests that Applicant explain this limitation using sections in the specification and drawings. The Examiner is referred to the Summary section of the previously filed Appeal Brief. Additionally, the following explanation is provided by way of example. As users access the web site, records may be stored in a database. When a new request for access is received, the Internet address and a time value corresponding to the new request may be compared to the records of previous access(es) to determine whether or not the new request should be identified as a distinct user. Thus, the records stored in the database may or may not include the Internet address and time value corresponding to a new request. If the Internet address and time value do not match one of the records in the database, the request may be considered as from a distinct user. Additionally, the criteria used to determine whether a new request should be considered a distinct user may vary from embodiment to embodiment. For example, in one embodiment, only if the a user has not previously accessed the web site within a specified period of time (e.g. 30 minutes) should a new access request from that user be considered a distinct user, such as for the purposes of counting the number of new “hits” to a web site, in one embodiment. *See Applicant’s specification, page 4, lines 17-26; page 12, line 25 – page 13, line 11; page 13, line 20 – page 14, line 9; page 14, line 23 – page 15, line 4; page 15, line 12 – page 9; and FIG. 4.*

### **Section 103(a) Rejections:**

The Examiner rejected claims 1-3, 5, 6, 8, 9, 11, 12, 14-16, 18-22, 24-26, 28-31, 33, 34, 36 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Shelton et al. (U.S. Patent 6,418,471) (hereinafter “Shelton”) in view of Holden et al. (U.S. Patent 6,272,639) (hereinafter “Holden”) in further view of Eichstaedt et al. (U.S. Patent 6,666,230) (hereinafter “Eichstaedt”). Applicant respectfully traverses this rejection for at least the reasons presented below.

**Regarding claim 1, Shelton in view of Holden in further view of Eichstaedt does not teach or suggest sending a request for information to the first computer, where the information comprises a first Internet address and a first time value corresponding to the first computer, as recited in claim 1.** The Examiner admits that Shelton fails to teach sending a request for information to the first computer where the request for information includes an Internet address and a time value corresponding to the first computer. The Examiner relies upon Holden, contending that Holden teaches sending a request for information that includes an Internet Address, citing column 12, lines 17-55 of Holden. At the cited reference, Holden describes the use of Address Resolution Protocol (ARP) messages to request the IP address for a computer. Holden teaches a system for secure communications for a “mixed enclave” network in which both secure and non-secure users can communicate. Holden’s system includes controls to ensure that information from a secure computer does not get transferred to a non-secure computer. However, Holden fails to teach sending a request for information, where the information includes an Internet address and a time value, as recited in Applicant’s claim 1. Nor does Shelton or Eichstaedt, whether consider alone or in combination with Holden, teach or suggest this limitation.

Eichstaedt, at the cited passage cited by the Examiner, describes a method for checking client request frequencies. Eichstaedt teaches a method implemented in a server which automatically recognizes when a client computer is making requests too frequently or is accessing too much of the server computer’s resources (col. 3, lines 46 –

49). Specifically, Eichstaedt obtains an IP address or other client identifier and determines if the client is on a deny list, in which case the client is refused (col. 7, lines 23 – 31). Eichstaedt further teaches that the server performs frequency checks, wherein the number of requests the client identifier has made within a predefined *time period*  $t_1$ , as determined from a log file, is compared with a predefined maximum number  $x_1$ . Furthermore, Eichstaedt teaches that a system administrator chooses values for  $t_1$  and  $x_1$ . If the client identifier has more than  $x_1$  requests, the client is added to the deny list. If the client identifier passes a last frequency check, the requested data object is sent (col. 7, lines 32 – 63). Thus, Eichstaedt's "time value  $t$ " referred to by the Examiner is not requested from a first computer, as recited in claim 1, but instead is set by a system administrator. Furthermore, it would not make sense for Eichstaedt to request time values from a computer system accessing the server because the entire purpose in Eichstaedt is for the server to determine if a client computer accesses the server too frequently during a time period determined *by the server*. Clearly the time value cannot be requested from the client computers for Eichstaedt's method to function properly. There is clearly no teaching or suggestion in any of the cited references, whether considered alone or in combination, of sending a request for information to the first computer, wherein the information comprises a first Internet address and a first time value corresponding to the first computer.

**In further regard to claim 1, the Examiner's proposed combination of Shelton, Holden and Eichstaedt fails to teach or suggest determining whether a matching record for the first Internet address and the first time value exists in the database, and identifying the first computer as a distinct user if the matching record does not exist in the database, as recited in claim 1.** The Examiner refers to col. 7, lines 23 – 63, of Eichstaedt in regard to these limitations of claim 1. As discussed above, Eichstaedt teaches a server implemented method that automatically recognizes when a client computer is making requests too frequently or is accessing too much of the server computer's resources (col. 3, lines 46 – 49). Thus, Eichstaedt teaches comparing *a number of requests made within a time period* to a predefined maximum number and **does not teach** determining if a time value contained in a matching record exists in a

database, as recited in claim 1. Furthermore, Eichstaedt teaches performing a series of frequency checks if a client identifier is not found in a deny list, but **does not teach identifying the first computer as a distinct user** if the matching record does not exist in the database. There is clearly no teaching or suggestion in any of the cited references, whether considered alone or in combination, of determining whether a matching record for the first Internet address and the first time value exists in the database, and identifying the first computer as a distinct user if the matching record does not exist in the database.

In a previous response to Applicant's arguments, the Examiner, in the Response to Argument's section of the Final Action dated August 26, 2004, cites Figure 3 and a related passage where Eichstaedt discusses Figure 3. The Examiner incorrectly contends that Eichstaedt teaches comparing a time period along with the number of requests with values stored in a database. However, contrary to the Examiner's assertion, Eichstaedt very clearly teaches:

"In step 56, the number of requests the client identifier [e.g. IP address] has made within a predetermined time period  $t_1$  is determined from the log file. Time period  $t_1$  may be any time period, from milliseconds to days, weeks, or even years. This *number of requests is compared with a predefined maximum number  $x_1$* . Values for  $t_1$  and  $x_1$  are chosen by the system administrator..." (emphasis added).

Eichstaedt does not mention, either in the cited passage or elsewhere, comparing a time period along with the number of requests with values stored in a database as argued by the Examiner. Instead, as shown above, Eichstaedt teaches comparing the number of requests made during a time period with a predefined maximum number of requests. Furthermore, Eichstaedt's teachings have absolutely nothing to do with determining whether a matching record for the first Internet address and the first time value exists in the database, and identifying the first computer as a distinct user if the matching record does not exist in the database, as recited in Applicant's claim 1. To the contrary, Eichstaedt's teachings pertain to recognizing when a client computer is making requests too frequently or is accessing too much of the server computer's resources.

Thus, none of the Examiner's cited prior art references, whether considered singly or in any combination teaches or suggests sending a request for information to the first computer (from which a first request to access the web site is received), wherein the information comprises a first Internet address and a first time value corresponding to the first computer, as recited in Applicant's claim 1. Instead, assuming such a combination was even proper, the Examiner's proposed combination of Shelton, Holden and Eichstaedt would result in a system which records browser activity, as taught by Shelton, but that also filters out requests from clients that access a web site too frequently, as taught by Eichstaedt, and sends ARP messages to determine the IP address for computer systems, as taught by Holden. The Examiner's proposed combination of Shelton, Holden and Eichstaedt would not include sending a request for information to a computer, where the information includes an Internet address and a time value corresponding to the computer. Nor would the proposed combination include determining whether a matching record for the first Internet address and the first time value exists in the database, and identifying the first computer as a distinct user if the matching record does not exist in the database.

**Moreover, the combination of references is not proper because the Examiner has not provided a proper motivation to modify Shelton in view of Holden in further view of Eichstaedt.** The Examiner contends that it would have been obvious to modify Shelton to include the ARP messages of Holden "because if a system does not know a computer's address utilizing ARP to query a computer's address is well known in the art and would only take one of ordinary skill to implement". The Examiner's statement motivation amounts to nothing more than stating that ARP messages are well known and able to be implemented by one of ordinary skill in the art. However, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (underlining in the original, M.P.E.P. 2143.01, para. 9). The Examiner has not presented any arguments nor cited any portion of either Shelton or Holden that suggests any desirability of modifying Shelton to use the ARP messages of Holden. Additionally, Shelton's system does not have any need for using ARP messages to

determine an Internet address for a computer. Shelton's system includes the use of multiple applets executing on client computers that are responsible for displaying and monitoring the data activities of the user through a web browser, sending information about the data activities to Shelton's WTS server, and coordinating with a Master applet (executing on the same computer) to exchange recorded data activities with other computers (parenthesis in original, Shelton, column 5, lines 9-45). Thus, Shelton's system includes active components on the client systems for which Shelton is recording browsing activities. Moreover, Shelton's applets are responsible for initiating communication with Shelton's WTS server (Shelton, column 5, lines 59-55). Thus, there is no need, nor desirability, for Shelton's system to use the ARP messages of Holden.

Furthermore, the Examiner's statement regarding how utilizing ARP to query a computer's address "is well known in the art and would only take one of ordinary skill to implement" does not provide a proper motivation to combine the references. As the Examiner is surely aware:

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon ... were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. (M.P.E.P. 2143.01, para. 10).

Additionally, as stated in the M.P.E.P. at 2143.01, paragraph 10, "[t]he level of skill in the art cannot be relied upon to provide the suggestion to combine references." Thus, The Examiner has clearly not provided a proper motivation to combine the references.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so in the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 488 (Fed. Cir.



1984). In regard to Eichstaedt, the reason given by the Examiner to combine the references is that “it would be more efficient for a system to update and log users interactions with a web sites which could aid in the determination in trends or stop invalid users (robots) from accessing site that would require human interaction for payment of services.” However, applying the method for automatically limiting access of a client computer to data objects taught by Eichstaedt to the web site in Shelton, as modified by Holden, would only serve to filter out browser interactions from robots and prevent the determination of trends. Filtering out browser interactions would defeat the intended purpose of Shelton to record all browser activity to the web site. If a proposed modification would render the prior art feature unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984). Therefore, the combination of Shelton, Holden and Eichstaedt is clearly improper.

In the Response to Arguments section of the Final Action dated August 26, 2004, the Examiner argues, “Shelton does not teach recording all browser activity.” The Examiner has misunderstood Applicants’ argument. Eichstaedt teaches a method to limit a computer’s access to a web site based on that computer’s access frequency and/or total amount of data downloaded. Shelton teaches a method for recording and reproducing browser activity. Shelton states as one of the objectives of his invention: “to record *the detailed browsing activities* of an individual browser” (column 2, lines 33-37). Shelton also states, as another object of his invention, “the ability to store *each* URL request and *each* piece of data entered into an HTML form ...” (column 2, lines 38-42). Thus, modifying Shelton to automatically deny access to the web site based on access frequency or total data accessed would render Shelton’s invention unsatisfactory for its intended purpose, e.g. to record detailed browsing activities and to store each URL request and each piece of data entered.

Furthermore, Applicant notes that Shelton’s teachings pertain to recording and reproducing *client-side browser activity* whereas Holden’s teachings pertain to secure communications within a mixed enclave network, and Eichstaedt’s teachings pertain to

monitoring access frequency and/or total amount of data downloaded *at a server*. Even if combined, the systems of Shelton in new view of Holden and modified according to Eichstaedt would still operate independently of one another. **Moreover, none of the Examiner's cited references have anything to do with determining a distinct user according to whether an Internet address and time value match a record in a database, as recited in claim 1.**

Thus, the Examiner's rejection of claim 1 is clearly not supported by the prior art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 1 also apply in regard to independent claims 9, 12, 15, 16, 19, 20, 26, 29, 30, 34 and 37.

Regarding claim 3, Shelton in view of Holden in further view of Eichstaedt does not teach or suggest that the time value is associated with a user-defined event and wherein the user-defined event is a launch of a web browser software on said first computer system. The Examiner cites column 10, lines 16-42 and column 10, line 61-column 11, line 7 where Shelton describes the contents of session table 145. However, the cited passages do not mention a time value associated with a user-defined event, wherein the user-defined event is a launch of a web browser. Shelton teaches that a session list in session table 145 may contain a StartTime and a StopTime respectively indicating the starting and stopping of a session. However, the StartTime for one of Shelton's sessions does not correspond to the launching of a web browser. Instead, Shelton teaches, "[a] session is created when a browser first hits web site 134" (Shelton, column 9, line 67 – column 10, line 1). The Examiner has not relied upon Eichstaedt or Holden for the rejection of claim 3 and both Eichstaedt and Holden fail to overcome any deficiency of Shelton regarding a time value associated with a user-defined event, wherein the user-defined event is a launch of a web browser. Thus, the rejection of claim 2 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks also apply to claims 22 and 31.

In further regard to claim 12, Shelton in view of Holden and Eichstaedt does not teach or suggest a client computer system is operable to receive a request for information from said web site server, wherein said information comprises a first Internet address and a first time value corresponding to said client computer system. The Examiner rejects claim 12 for the same reasons as claim 1, discussed above. For a more detailed discussion regarding the limitations of Shelton in view of Holden and Eichstaedt regarding a client computer receiving a request for information including an Internet address and a time value corresponding to the client computer, please refer to the relevant arguments presented above regarding claim 1, as they apply to claim 12 as well.

Additionally, Shelton in view of Holden and Eichstaedt fails to teach or suggest a client computer system operable to execute a program to synchronize time. **The Examiner has completely ignored this limitation of claim 12.** None of the Examiner's cited references, whether considered singly or in combination, mentions anything regarding a client computer system operable to execute a program to synchronize time.

In further regard to claim 16, Shelton in view of Holden and Eichstaedt does not teach or suggest storing one or more identifiers, wherein each identifier comprises an Internet address and a time value; receiving a request from a first computer user to access the web site, wherein said requests comprises a first identifier corresponding to said first computer user accessing said web site. The Examiner rejects claim 16 for the same reasons as claim 1, discussed above. **The Examiner has improperly ignored differences between claims 1 and 16.** For example, claim 16 recites receiving a request from a computer user to access the web site, where the request comprises a first identifier corresponding to the computer user. The Examiner has failed to cite any portion of the prior art or to provide any arguments regarding this limitation of claim 16. Nowhere does Shelton, Holden or Eichstaedt, either separately or in combination, mention anything regarding receiving a request to access the web site that includes an identifier corresponding to a computer user.

Additionally, Shelton in view of Holden and Eichstaedt fails to teach or suggest searching for a matching identifier; and identifying the first identifier as a distinct computer user if said searching for said first identifier did not result in a match, as presented in claim 16. For a more detailed discussion regarding the failure of Shelton in view of Holden and Eichstaedt to teach or suggest identifying a computer user as distinct if a search for a matching identifier does not result in a match, please refer to the relevant arguments presented above regarding claim 1, as they apply to claim 16 as well.

In further regard to claim 20, the Examiner's combination of Shelton, Holden and Eichstaedt fails to teach or suggest receiving a request from a first computer user to access the web site, wherein said request comprises an Internet address and a time value corresponding to said first computer user accessing said web site, as presented in claim 20. The Examiner rejects claim 20 for the same reasons as claim 1, discussed above. **The Examiner has improperly ignored differences between claims 1 and 20.** For example, claims 20 and 30 recite receiving a request from a computer user that comprises an Internet address and a time value. The Examiner has failed to cite any portion of the prior art or to provide any arguments regarding this limitation of claim 20. Furthermore, neither Shelton, Holden nor Eichstaedt, either separately or in combination, mentions anything regarding receiving a request to access the web site that includes an Internet address and a time value.

Additionally, Shelton in view of Holden and Eichstaedt does not teach or suggest comparing said time value and said Internet address with a database of time value information and Internet address information compiled from previous web site accesses. As discussed above regarding claim 1, Eichstaedt teaches comparing *a number of requests made within a time period* to a predefined maximum number and clearly fails to teach anything regarding comparing a time value and an Internet address with a database of time value information and Internet address information compiled from previous web site accesses. For a more detailed discussion regarding the failure of Shelton in view of Holden and Eichstaedt to teach or suggest comparing a time value and an Internet address with a database of time value information and Internet address information, please refer

to the relevant arguments presented above regarding claim 1, as they apply to claim 20 as well.

In further regarding to claim 30, Shelton in view of Holden and Eichstaedt fails to teach or suggest receiving a request from a first computer user to access the web site, wherein said request comprises an Internet address and a time value corresponding to said first computer user accessing said web site, as presented in claim 30. The Examiner rejects claim 30 for the same reasons as claim 1, discussed above. **The Examiner has improperly ignored differences between claims 1 and 30.** For example, claim 30 recites receiving a request from a computer user that comprises an Internet address and a time value. The Examiner has failed to cite any portion of the prior art or to provide any arguments regarding this limitation of claim 30. Furthermore, Shelton, Holden and Eichstaedt, either separately or in combination, fail to mention anything regarding receiving a request to access the web site that includes an Internet address and a time value.

Additionally, Shelton in view of Holden and Eichstaedt does not teach or suggest comparing said time value and said Internet address with a database of time value information and Internet address information compiled from previous web site accesses. As discussed above regarding claim 1, Eichstaedt teaches comparing *a number of requests made within a time period* to a predefined maximum number and clearly fails to teach anything regarding comparing a time value and an Internet address with a database of time value information and Internet address information compiled from previous web site accesses. For a more detailed discussion regarding the failure of Shelton in view of Holden and Eichstaedt to teach or suggest comparing a time value and an Internet address with a database of time value information and Internet address information, please refer to the relevant arguments presented above regarding claim 1, as they apply to claim 30 as well.

The Examiner rejected claims 4, 7, 10, 13, 17, 23, 27, 32 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Shelton, Holden and Eichstaedt as applied above,

and further in view of Bodnar et al. (U.S. Patent 6,295,541) (hereinafter “Bodnar”). Applicant respectfully traverses this rejection for at least the following reasons.

Regarding claim 7, Shelton in view of Eichstaedt in further view of Bodnar does not teach or suggest identifying the first computer user as a distinct computer user only if the matching record does not exist in the database or if the timestamp for the matching record is older than a predetermined maximum time. The Examiner admits that Shelton and Eichstaedt fail to teach the limitations of claim 7. The Examiner cites Bodnar, column 27, line 40-column 28, line 31. However the cited passage describes how Bodnar determines and deals with clock drift in his record synchronization system. Determining and handling clock drift and error in a record synchronization system does not teach or suggest identifying a computer user as a distinct computer user only if a matching record does not exist in a database or if the timestamp for the matching record is older than a predetermined maximum time. The only maximum time mentioned by Bodnar, in the cited passage or elsewhere, is the maximum presumed range a clock may have drifted since a last synchronization (Bodnar, column 27, lines 40-43).

Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

Applicant submits the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicant hereby petitions for such extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00200/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Appeal
- ☐ Other:

Respectfully submitted,



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